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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT J. BROUSSARD

Appeal 2007-3520
Application 09/870,614
Technology Center 2100

Decided: March 31, 2008

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
LANCE LEONARD BARRY, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-22. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellant's invention relates to dynamic buffering of graphic images by a platform independent application program interface. The present invention remedies select situations in the Swing interface which remedies situations in the Abstract Windowing Toolkit of Java (Spec. 1). The graphical representation of the object may, in some cases, be temporarily stored within a display buffer (e.g., memory 18 or processor 12 of Fig. 1) before the graphical representation is forwarded to a display device (display 16, Fig. 1). As described in more detail below, the Appellant's claimed invention more specifically relates to a system and method for enabling/disabling buffering of the graphical representation (Spec. 34:12 - 35:25, and Abstract). (Br. 3). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A display system, comprising:

a display;

a display buffer coupled to the display; and

a processor adapted to execute an application program which, when executed, produces images upon the display, wherein during a first mode the images are forwarded in sequence to the display, and wherein during a second mode the images are compiled as a combination image of at least one of said image drawn over at least another of said images and presented to the buffer before being forwarded to the display.

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reasoning in support of the rejections, and to Appellant' s Brief (filed November 15, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellant's Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellant and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

"It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. . . . Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343,

1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted).
"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

"[A] prima facie case of anticipation [may be] based on inherency." *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product."). *See also In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

With respect to independent claim 1, Appellant argues that the conventional Swing-based API's default to buffering their graphical output and that in some cases the default buffering of Swing images may lead to sub-optimal performance. Appellant argues that the invention as recited in independent claim 1 improves the performance of conventional Swing-based API's by providing a display system, which is uniquely configured for enabling/disabling image buffering before the images are sent to the display.

Appellant argues that if buffering is disabled, the images are forwarded in sequence to the display (during a first mode) and if buffering is enabled, at least two of the images may be compiled as a combination image. The combination image may then be presented to the display buffer before it is forwarded to the display (during a second mode) (Br. 7-8).

Appellant distinguishes the teachings of the DiNicola reference and argues that DiNicola fails to anticipate a display system as claimed in independent claim 1 since DiNicola fails to provide any teaching or suggestion for a display system including a display, a display buffer, and a processor which is adapted to produce images upon a display, such that during a second mode at least two images are compiled as a combination image and presented to the display buffer before the combination image is forwarded to the display (Br. 7-8). Appellant distinguishes the Examiner's reliance upon column 3 of DiNicola and in figure 1 of DiNicola since DiNicola's image mixing process is performed downstream of the memory buffers 24, 26, 28, and 30, and the merged images are passed through the color translation table 34 which generates the appropriate control signals to be passed on data line 40 to the display monitor 50 as described in column 4 of DiNicola. Appellant maintains that DiNicola clearly states that the combined image (mixed images) are passed directly to the display monitor, and DiNicola does not teach or suggest that the combined images may be stored within the memory buffers 24, 26, 28, and 30 or within any other memory buffer before the combined images are forwarded to the display monitor (Br. 8).

From our review of the teachings of the DiNicola reference, we agree with Appellant that DiNicola does not expressly teach nor inherently buffer the mixed image before forwarding the mixed image to the display. The Examiner maintains at page 20 of the Answer that independent claim 1 only states that images are presented to a buffer before being forwarded to the display and not necessarily that the composite display image may be stored in memory buffers. We disagree with the Examiner's interpretation of independent claim 1 because the limitation concerning the combination image is the one expressly recited as being buffered before being forwarded to the display. Therefore, we find that the Examiner's claim interpretation to be unreasonable in light of the express limitations of independent claim 1.

With respect to Appellant's argument concerning the teaching in DiNicola of the "intentional absence of an intermediate frame buffer" at page 10 of the Brief, the Examiner contends that the contemplation in the text of DiNicola concerning an intermediate frame buffer existing is "sufficient enough to assert that a buffer can be located at this post compilation location." (Ans. 21). Here, the Examiner speculates as to an undisclosed alternative embodiment which may or may not be desirable from the teachings of DiNicola. This speculation is inappropriate under a rejection based upon anticipation wherein the post compilation buffer is neither disclosed nor inherently present in DiNicola. Therefore, the element is lacking within the four corners of the teaching, and we make no findings regarding the obviousness of this feature since the Examiner rejected independent claim 1 based solely upon anticipation. Therefore, we cannot

sustain the Examiner's rejection based upon anticipation of independent claim 1 and dependent claim 2.

With respect to independent claim 5, the Examiner relies upon the teachings of DiNicola at columns 3 and 5 to teach the use of an intermediate buffer that is not required, as a matter of asserted efficiency, but mentioned in the reference (Ans. 5). Again, the Examiner's reliance upon buffers 24, 26, 28, and 30 is misplaced since these upstream buffers are not taught or suggested to buffer the composite display image as expressly disclosed by DiNicola. Therefore, we cannot agree with the Examiner's conclusion that DiNicola anticipates independent claim 5 and dependent claim 6.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court

can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

With respect to independent claims 12 and 19, we find that each claim to be slightly different in scope than independent claim 5 wherein independent claims 12 and 19 do not expressly set forth a combination image but rather recite creating a graphical representation and enabling or disabling buffering of that created graphical representation. Appellant argues that DiNicola does not teach or suggest that memory buffers 24, 26, 28, and 30 could be disabled in certain circumstances, and since no other memory buffers are disclosed by DiNicola, then DiNicola cannot be relied upon to teach or suggest the presently claimed enabling/disabling the buffering of the graphical representation of an object (Br. 18). We agree with Appellant’s argument. In addition, we do not find that memory buffers 24, 26, 28, and 30 can reasonably be interpreted as the enabled buffers since the graphical representation is not created until it is mixed in DiNicola. Nor do we find that the teachings of Sun remedy this deficiency in DiNicola. Therefore, we do not find that the Examiner has set forth a sufficient initial showing of obviousness of independent claims 12 and 19 and their respective dependent claims under 35 U.S.C. § 103.

CONCLUSION

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To summarize, we have reversed the rejection of claims 1, 2, 5, and 6 under 35 U.S.C. § 102, and we have reversed the rejection of claims 3, 4, and 7-22 under 35 U.S.C. § 103(a).

REVERSED

clj

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